



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jan Yngvar PIENE, et al. Confirmation No.: 6150
Appl. No. : 09/831,553
Filed : May 11, 2001
Title : PROCESS FOR PREPARING ORAL CALCIUM
COMPOSITIONS

TC/A.U. : 1623 **ATTENTION: BRYAN LIN**
Examiner : D. Khare

Docket No.: : PIEN3001C/REF
Customer No: : 23364

PETITION UNDER 37 C.F.R. 1.181

MS: PCT LEGAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the decision of December 7, 2007, in connection with petition in application 11/798,519, Petitioners hereby request that the USPTO records be corrected to reflect the correct status of Application No. 09/831,553, now abandoned, which is the grandparent application of pending application 11/798,519. It is requested that the USPTO records be corrected to reflect that application 09/831,553 was filed as a CIP of PCT/GB99/03666 on May 11, 2001 and not November 5, 2001. The required fee of \$130.00 under 37 CFR 1.81 is submitted herewith.

This request is based upon belief that ambiguous filing instructions lead to the processing of the '553 application as a national stage application when the intention was to file the application as a continuation-in-part under 35 U.S.C. 111(a) and not to enter the national phase under 35 U.S.C. 371. MPEP §1893.03(a) is noted wherein it is stated that, "Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a). It is clear from the record that there were conflicting instructions

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present and the application should have been treated as an application under 35 U.S.C. 111(a) in accordance with the stated MPEP procedure.

Petitioners note MPEP §1002.02(p) which refers to 37 CFR 1.182 to convert a national application which was filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a). It is not believed that 1.182 applies to the present case but if so, any additional petition fee required for granting of this petition may be charged to the undersigned's Deposit Account 02-0200.

STATEMENT OF FACTS

The undersigned attorney is the attorney of record in connection with application serial no. 11/798,519 which was filed as a continuation of Application No. 10/973,352 filed on October 27, 2004, now abandoned, as a continuation of Application No. 09/831,553 filed November 5, 2001 (actually May 11, 2001), now abandoned, which is a continuation-in-part of PCT/GB99/03666 filed November 5, 1999, a copy of the Official Filing Receipt mailed June 21, 2007 is submitted herewith as **Exhibit A**.

The undersigned attorney did not file the '553 application and the information presented herein is based on the undersigned's detail review of the application files as present in the IFW of the USPTO.

Also submitted herewith as **Exhibit B** is a copy of a response to request for corrected filing receipt in connection with Application No. 11/798,519 indicating that the filing date of a parent application cannot be changed by the request. A petition to correct the filing date in the parent application is required. The parent application which has been incorrectly designated as Application No. 09/831,553, now abandoned. The filing date needs to be corrected from November 5, 2001 to May 11, 2001, the date on which a complete application was filed as is evident from the image file wrapper (IFW) at the USPTO.

A copy of the transmittal letter to the United States Designated/Elected Office concerning a filing under 35 U.S.C. 371 is attached here as **Exhibit C**. This transmittal

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document bares a patent office date receipt stamp of 11 May 2001. While it was clear that this is the appropriate form for entering a national stage, in Item 20 entitled Other Items Or Information, Sub-item D states that this application is a continuation-in-part of international Application No. PCT/GB99/03666 filed on November 5, 1999 which claims benefit of GB 9825033.5 filed November 13, 1998. Item 15 on this page indicates that a first preliminary amendment is also submitted.

A copy of the first page (**Exhibit D**) of this preliminary amendment is attached as received on May 11, 2001. This preliminary amendment requests that the application be amended to state that this application is a continuation-in-part of international Application No. PCT/GB99/03666 filed on November 5, 1999 which claims the benefit of GB 9825033.5 filed on November 13, 1998. This is clearly the statement required under 35 U.S.C. 120 for a continuation-in-part filed under 35 U.S.C. 111(a).

As stated in MPEP §1895, continuation-in-part applications are generally filed in instances where applicants seek to add matter to the disclosure which is not supported by the disclosure of the international application as originally filed, as new matter may not be added to a U.S. national stage application. See 37 CFR 1.121(f).

At the time of filing of application 09/831,553, a copy of the published PCT application was filed in addition to a new specification for the CIP containing additional subject matter. The undersigned attorney has compared the published PCT application which appears to correspond to the PCT application as filed with the specification submitted on May 11, 2001 as published on October 20, 2005 as U.S. 2005/0232989 which is a publication of Application No. 10/973,352 which is a continuation of Application No. 09/831,553.

The published application contains paragraphs [0043] to [0048] which were added to the PCT application and which forms the basis of the added subject matter for the continuation-in-part application. This added subject matter may be found with the specification as filed on May 11, 2001 beginning on page 11, line 30 continuing on page 12 and ending at line 2 on page 13.

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Petitioner respectfully submits that at this juncture, the application should have been considered as having conflicting instructions in view of the request for national phase entry coupled with the notification in the same document that the application was filed as a continuation-in-part of the PCT application. In this regard, MPEP §1893.03(a) is noted wherein it is stated that,

“Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a). A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371 a “utility patent application transmittal” (Form PTO/SB/05) or includes a benefit claim under 35 U.S.C. 120 to the international application. Applications that have been processed under 35 U.S.C. 371 and later found by the Examiner to contain conflicting instructions should be forwarded to the Office of PCT Legal Administration for resolution.”

A notification of missing requirements (**Exhibit E**) under 35 U.S.C. 371 in the United States Designated/Elected Office was forward to Petitioner's then attorney on July 5, 2001.

An executed Declaration was filed in response to the notice. A copy of this executed Declaration is submitted herewith as **Exhibit F** and includes the designation for the PCT/GB99/03666 under 35 U.S.C. 120. The executed Declaration was filed on November 5, 2001.

The filing of the missing parts served to complete the application which was treated as entry into the U.S. national phase and the date of completion was included on the Official Filing Receipt as the date of receipt of the missing part which was November 5, 2001.

From a review of the record, the Examiner prosecuting the application apparently did not note the conflicting instructions and the application should have been forward to the Office of PCT Legal Administration for resolution. Instead the application was prosecuted in the usual manner and ultimately abandoned in favor of a continuation application.

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REQUEST FOR CORRECTED FILING DATE

Accordingly, it is most respectfully requested that the Office of PCT Legal Administration resolve the issue that the application was in fact filed under 35 U.S.C. 111(a) based upon the evidence in the file wrapper and that the USPTO database be corrected to reflect a filing date of May 11, 2001 for Application Serial No. 09/831,553 filed May 11, 2001 so that a corrected filing receipt can be issued in pending Application No. 11/798,519 which does not indicate a discrepancy with the patent office database. This is necessary to ensure that the correct filing date of May 11, 2001, is associated with the added subject matter in the CIP application 11/798,519 and the corresponding continuation applications.

Respectfully submitted,
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